APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,561	12/22/1999	MARTIN PAGEL	045923-P016U	5104

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EXAMINER
WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.		Applicant(s)	
Office Action Summary	●	09/469,561	●	PAGEL	
		Examiner		Art Unit	
		Richard Woo		3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19,21-28,30-34 and 36-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19,21-28,30-34 and 36-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1)   Applicant's amendment filed July 14, 2003 has been entered and

acknowledged.

2)   Applicant's arguments, filed July 14, 2003, with respect to rejections under

35 U.S.C. 102 have been fully considered and are persuasive. The previous

rejections of all Claims have been withdrawn.

Claim Rejections - 35 USC § 101

3)   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

4)   Claims 1-19, 21-22, 33-34, 36-46 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

In Claim 1, the invention is directed to a "driver" and this is typically

considered software. E.g. according to "Whatis.com", "driver is a program that

interacts with a particular device or special (frequently optional) kind of software.

The driver contains the special knowledge of the device or special software

interface that programs using the driver do not. In personal computers, a driver

is often packaged as a dynamic link library (DLL) file." Accordingly, Claim 1 is

directed to software *per se* and is non-statutory unless the specifications of the

applicant takes a special definition different from the norm or industry standard

and requires structure or hardware as part of the "driver".

In Claim 33, the invention is directed to a computer program product but doesn't expressly recite a computer readable medium. Even if the applicant can further argue that this product is the computer readable medium, the computer readable medium itself cannot be directed to a practical application of the invention in the useful art to accomplish a concrete, useful, and tangible result. When the computer readable medium is actually <u>executed by the computer</u>, the claimed subject matter produces a useful, concrete and tangible result.

Claim Rejections - 35 USC § 112

5)   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6)   Claims 23-28, 30-32 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step(s) is: **printing certain information on a printed document**, as the preamble of the Claim 23 is directed to the method of printing certain information on a printed document.

Claims 2-11, 18, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 2, the recitation of "said at least one additional function comprises printing of address information on material separate from said printing information in accordance with said data stream" renders the claim indefinite

because the additional function in Claim 1 is specifically spelled out as "printing

of a postage indicia." Dependent claims 2-11, 18 and 36 (similarly) recite that

"said" additional function "comprises" functions that are not tied to the printing of

postage indicia. This probably should be "further comprising" since it shouldn't

be replacing the "printing of postage indicia".

In Claim 3, lines 2-3, the recitation of "said printing" renders the claim

indefinite because it is not clear which printing the applicant intends to claim.

In Claim 46, line 1, the recitation of "said data patterns" lacks antecedent

basis.

Claim Objections

7)   Claim 32 is objected to because of the following informalities:

In Claim 32, line 9, --; and-- should be inserted after ")".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

8)   Claims 1-4, 7-8, 12-13, 16, 23-24, 31-34, 37-38 and 46, as far as Claims

are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by

As for Claim 1, Dietrich et al. discloses a printer driver comprising:

means for abstracting at least a portion of a data stream (see Figure;

abstract and col. 1, lines 39-56);

means for using the abstracted data for controlling the function of printing

of postage indicia (see col. 1, lines 46-52, 58-60); and

means for creating data for controlling the printing of the postage indicia

(see Id.).

As for Claim 2, Dietrich et al. further discloses the driver wherein the printing of

address information on material is separate from the printing information in

accordance with the data stream (see Figure for separate printings);

As for Claim 3, Dietrich et al. further discloses the driver wherein the printing of

postage indicia is separate from printing (see Figure for two separate printers);

As for Claim 4, Dietrich et al. further discloses the driver wherein function

includes a dialog box for allowing options from a user (any personal computer

inherently must have the user input interface);

As for Claim 7, Dietrich et al. further discloses the driver wherein the function

includes storing data a memory (every computer device must have the memory);

As for Claim 8, Dietrich et al. further discloses the driver wherein the abstracted

portion is directed to a viewable medium (e.g. monitor);

As for Claim 12, Dietrich et al. further discloses the driver wherein the printer

driver is operable on the data stream coming from a program operating in a

computing device to control at least a portion of the printing of the printer (see

Figure for the information carrier and read/write device that are linked to control

the postage meter device and address printing device);

As for Claim 13, Dietrich et al. further discloses the driver wherein the printer

driver is located remote from the personal computer (see Figure); and

As for Claim 16, Dietrich et al. further discloses the driver wherein the data

patterns are selected from the list including: return address, destination address,

beginning and ending of postage indicia data, beginning and ending of address

information, beginning and ending of document and the number of pages of the

document (see Supra columns).

As for Claim 23, Dietrich et al. discloses a method comprising the steps of:

sending a data stream to a printer (see Figure);

reviewing the data stream to create a separate data stream (see the

separate links between the postage meter device and address printing device);

maintaining in a secure memory an amount available for controlling a

generation of a postage indicia (see Figure; abstract; and col. 1, lines 39-56);

calculating an amount of postage (for a particular printing) under joint

control of the secure memory and the separate date stream (see col. 1, lines 46-

52, 58-60); and

deducting the calculated postage amount from the secure memory when

the calculated postage amount is available in the secure memory (see Supra

columns).

As for Claim 24, Dietrich et al. further discloses the method, wherein at least one

function includes printing address information or printing postage information;

As for Claim 31, Dietrich et al. further discloses the method, wherein the

reviewing step includes the step of enabling a dialog box (see Supra Claim 4);

As for Claim 32, Dietrich et al. further discloses the method, wherein the dialog

box interacts with a user to provide return address and logo (col. 3, lines 1-15);

As for Claim 33, Dietrich et al. discloses a computer readable medium,

when executed by a computer processor, including:

an abstracting program operable for reviewing the data stream to obtain

information for controlling printing operations (such as printing postage indicia);

and

a controller working in cooperation with the abstracting program and with

the information for controlling the printing of a postage indicia on material (see

Figure and Supra columns for calculating the postage value based on the

address information).

As for Claim 34, Dietrich et al. further discloses the medium including the

operation printing of address information on material separate from material (see

Figure for the separate address printing device);

As for Claim 37, Dietrich et al. further discloses the medium wherein the

computer medium is operable on the data stream coming from a general

personal computer (see Figure);

As for Claim 38, Dietrich et al. further discloses the medium, wherein the medium

is located remote from the computer (see Figure for the IC, R/W device); and

As for Claim 46, Dietrich et al. further discloses the medium, wherein data

patterns include return address, destination address and postage indicia.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

EP 0927581 is cited to show a method and system for determining an

address from a print buffer stream.

EP 0974914 is cited to show a method of capturing a destination address

from a label print stream in a data processing system which is capable of

supporting an object oriented programming environment.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Richard Woo whose telephone number is

703-308-7830. The examiner can normally be reached on Monday-Friday from

8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax

phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

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direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

Richard Woo
Patent Examiner
Art Unit 3629
January 4, 2005

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